

REMARKS

This application has been amended so as to place it in condition for allowance at the time of the next Official Action.

The Official Action rejects claims 1-7, 9, and 10 under 35 USC §102(b) as being anticipated by, or in the alternative, under 35 USC §103(a) as obvious over WALLACE. Reconsideration and withdrawal of this rejection are respectfully requested for the following reasons:

The Official Action identifies those elements of the device as recited that are interpreted as being disclosed by the applied WALLACE reference. Applicants acknowledge that the WALLACE reference can be characterized as having a substantially cylindrical body and at least one fin extending therefrom. Figure 7 of WALLACE is offered as evidence of the device with the fin or fins in a position folded against the body. WALLACE Figure 6 is offered for indication of the device with the fin or fins extending farther away from the body.

The Official Action acknowledges that the WALLACE reference offers no specific disclosure, teaching, or suggestion of the characteristic that the transition from the folded position to the extended position is caused by the construction of the device from heat-deformable materials. The Official Action states, however, that a *prima facie* case for rejection has been established when the reference discloses all the limitations of a claim except for property or function and the Examiner

cannot determine whether or not the reference inherently possesses such properties.

Applicants respectfully suggest that it is quite possible for the Examiner to determine whether or not the reference inherently possesses properties as claimed, particularly as now claimed in amended claim 1 and new independent claim 11. Amended claim 1 recites, among other features, that the at least one fin is arranged to take up an outside position when the device is outside the lachrymal meatus. In such outside position, the fin is substantially folded into the cylindrical body.

In the WALLACE device, there is no condition or time at which the device is outside the lachrymal meatus and having a position in which the fin is substantially folded into the cylindrical body 10. Figure 6 of WALLACE ably demonstrates the condition of the WALLACE device immediately prior to insertion. In this condition, the fins clearly fail to meet the feature of being outside the lachrymal meatus and substantially folded into the cylindrical body. As is clear from Figure 7 and the associated text, it is only upon the insertion of the device into the punctal ring R that the fins are deflected into position in which they are nearer the cylindrical body.

In addition to such amendment to claim 1, applicants have added new claims 11-19. Of these, claim 11 is an independent claim from which each of claims 12-19 ultimately

depends. Claim 11 is also directed to a meatal occluder and is recited as comprising a substantially cylindrical body having a longitudinal axis as well as at least one fin. The at least one fin is recited as comprising a heat-deformable material, with such at least one fin being positioned to extend from the cylindrical body substantially parallel to the longitudinal axis.

New claim 11 additionally goes on to recite that the cylindrical body and at least one fin are constructed and arranged so that exposure of the heat-deformable material to a heating effect of a human body causes the at least one fin to move from the position of being arranged substantially parallel to the longitudinal axis to a position of projecting outward from the longitudinal axis. This characteristic of the present invention is clearly described in the first full paragraph on page 10 of the present specification.

New independent claim 11 therefore recites the present apparatus in terms of its structure as well as composition. Moreover, such a structure, its arrangement, and its composition are specifically recited in such a manner so as to define a cause and effect relationship between two different positions of the fin with respect to the cylindrical body and a temperature to which the device is exposed. Applicants respectfully suggest that there is no reasonable way to interpret the WALLACE reference in such a way as there to be any doubt as to whether

the device disclosed therein might inherently possess the particular recited properties.

For these reasons, applicants respectfully suggest that the present rejection cannot be maintained, and reconsideration and withdrawal of such rejection are therefore respectfully requested.

The Official Action rejects claim 8 under 35 USC §103(a) as being unpatentable over WALLACE in view of FOUERE. The additional FOUERE reference is offered merely for its asserted description of a fin pivoting between the folded position and an extended position about an axis parallel to the longitudinal direction of the cylindrical body. However, irrespective of the ability of this reference to teach or suggest that for which it is specifically offered, it nevertheless fails to overcome the shortcomings of the primary WALLACE reference.

Accordingly, the combination of references necessarily fails to render obvious the full set of features explicitly recited in claim 8 and implicitly recited in claim 1, from which it depends. Accordingly, and in light of the analysis provided above in connection with the preceding rejection, applicants respectfully suggest that the present rejection cannot be maintained, and withdrawal of such rejection is therefore respectfully requested.

In light of the amendments provided above and the arguments offered in support thereof, applicants believe that the

present application is in condition for allowance and an early indication of the same is respectfully requested.

If the Examiner has any questions or requests clarification of any of the above points, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number listed below.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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